

Jun 07 05 02:12p

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PATENT DIVISION
408 971 4660



ZILKA-KOTAB

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FAX COVER SHEET

Date: June 7, 2005	Phone Number	Fax Number
To: Petitions Division, USPTO		(703) 872-9306
From: Dominic M. Kotab		

Docket No.: IBM1P008/SJ09-2001-0135US1

App. No: 09/938,457

Total Number of Pages Being Transmitted, Including Cover Sheet: 10

Message:

Please deliver to the Petitions Division.

Thank you,

Dominic M. Kotab

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☐ Original to follow Via Regular Mail ☒ Original will Not be Sent ☐ Original will follow Via Overnight Courier

06/10/2005 DALLIN 00000016 090466 09938457

01 FC:1464 130.00 DA

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AT (408) 971-2573 AT YOUR EARLIEST CONVENIENCE

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DIVISION

P. 2

JUN 07 2005



Practitioner's Docket No. IBM1P008/SJ0920010135US1

205 JUN -9 AM 9:30 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Robert G. Biskeborn

Application No.: 09/938,457

Group No.: 11/04/2004

Filed: 08/23/2001

Examiner: Eley, Timothy V.

For: PIN ADAPTER FOR AIR BEARING SURFACE (ABS) LAPPING AND METHOD FOR USING THE SAME

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Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

JUN 13 2005

OFFICE OF PETITIONS

PETITION TO WITHDRAW HOLDING OF ABANDONMENT
— OFFICE ACTION NOT RECEIVED

1. In response to the Notice of Abandonment mailed 6/3/2005, I hereby petition to withdraw the holding of abandonment in this case, on the basis that the Office Action forming the basis of the abandonment was not received.
2. I hereby state:
 - (a) The Office Action indicated, as mailed on November 4, 2004, was not received.
 - (b) A search of the file jacket and the docket records in my office indicates that this Office Action was not received.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

— deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. § 1.8(a)

— with sufficient postage as first class mail.

37 C.F.R. § 1.10*

— as "Express Mail Post Office to Addressee"

Mailing Label No. _____ (mandatory)

TRANSMISSION

✓ facsimile transmitted to the Patent and Trademark Office, (703) 872-9306.

Date:

6/7/2005

Signature

Erica L. Farlow

Erica L. Farlow

(type or print name of person certifying)

* Only the date of filing (1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under 1.8 continues to be taken into account in determining timeliness. See 1.703(f). Consider "Express Mail Post Office to Addressee" (1.10) or facsimile transmission (1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

Petition to Withdraw Holding of Abandonment—Office Action Not Received—page 1 of 2

3. I attach a copy of the docket record where the non-received Office Action would have been entered had it been received and docketed. Please see page 2 of Exhibit A. This shows how the entry would have appeared on our docket.

4. As additional evidence of non-receipt of the Office Action, I also attach:

Exhibit B is a copy of the PAIRConnect Patent Record which shows a direct comparison of the PTO Action Items on the PAIR system and the IP Master Actions listed in our docketing database. The PAIR column shows the mailing of the Non-Final Rejection on 11/04/2004, but there is no action noted as received on our side.

5. In consideration of these submissions, it is respectfully requested that the holding of abandonment be withdrawn.

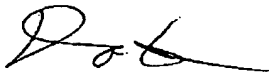
6. The petition fee (37 C.F.R. § 1.17(h)–\$130.00) is paid as follows:

Should the Commissioner find that a fee is necessary, authorization is hereby made to charge the amount of \$130.00 to Deposit Account No. 09-0466 (Order No. SJ0920010135US1).

Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

Reg. No.: 42,762
Tel. No.: 408-971-2573
Customer No.: 50535



Signature of Practitioner
Dominic M. Kotab
Zilka-Kotab, PC
P.O. Box 721120
San Jose, CA 95172-1120
USA

Practitioner's Docket No. IBM1P008/SJ0920010135US1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Robert G. Biskeborn

Application No.: 09/938,457

Group No.: 11/04/2004

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37 C.F.R. § 1.10*

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Mailing Label No. _____ (mandatory)

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Erica L. Farlow

(type or print name of person certifying)

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Petition to Withdraw Holding of Abandonment—Office Action Not Received—page 1 of 2

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Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.



Signature of Practitioner
Dominic M. Kotab
Zilka-Kotab, PC
P.O. Box 721120
San Jose, CA 95172-1120
USA

Reg. No.: 42,762
Tel. No.: 408-971-2573
Customer No.: 50535

Patent Case Print [ID 201]

Page 1 of 3

Exhibit A

Patent: IBM1P008, United States, Regular, National,
Original Filing

Patent Data

Docket No	IBM1P008	Senior Attorney	Dominic M. Kotab
Country	United States	Primary Attorney	
Case Type	Regular	Client/Division	International Business Machines
Relation Type	Original Filing	Current Owner	International Business Machines
Filing Type	National	Previous Owner	
Filing Number		Client Case No.	SJ09-2001-0135US1
Status	Filed	First Filing Date	8/23/2001
Sub Status		Sub Status Date	
Parent Country		Parent Filing Date	
Parent Number		Parent Grant Date	
Application Number	09/938,457	Application Date	8/23/2001
Patent Number		Grant Date	
Publication Number	2003-0040257	Publication Date	2/27/2003
Assigned	Assignment Recorded	Ind. Claims/Designs	0
Convention Type	No Foreign Filing	Total Claims	0
Req Not To Pub Incl	No	Total Classes	
Tax Agent		Confirmation Number	
Firm Attorney		Tax Base Date	
Administrator		Next Tax Date	
Custom Party #2		Expiration Date	
Custom Party #3		Custom Text #1	
Custom Party #4		Custom Date #1	
Custom Party #5		Alt Case No	
Custom Party #6		Priority Date	
Custom Party #7		US Case No	
Custom Party #8		Custom Date #3	
Firm Case Number		Custom Text #4	
Custom Code #2		Custom Date #4	
Custom Code #3		Text #5	
Custom Code #4		Text #6	
Custom Code #5		Text #7	
Custom Code #6		Text #8	
Custom Code #7		Confirm No	
Customer Code		Customer Name	Silicon Valley IP Group

Title

Pin Adapter For Air Bearing Surface (Abs) Lapping And Method For Using The Same

Description**Current Expense Information****Other Case-Related Information****Actions**

Action Code	Action Due Date	Taken Date	Deadline Date	Completed Date	Post Card Received	Who	Action Notes
Recorded				2/28/2002		Dominic M. Kotab	To International Business Machines Corporation
Assignment Received							

RECEIVED**JUN 13 2005****OFFICE OF PETITIONS**

Patent Case Print [ID 201]

Page 2 of 3

Office Action		9/10/2003		Dominic	
Mailed Date				M. Kotab	
Office Action		1/29/2004		Dominic	
Mailed Date				M. Kotab	
Office Action		4/13/2004		Dominic	
Mailed Date				M. Kotab	
Filing Receipt		1/10/2002		Dominic	
				M. Kotab	
Notice of missing parts mail d		9/26/2001		Dominic	
				M. Kotab	
File Audit Date		10/26/2004			
Notes		5/6/2005			During an ongoing file audit, I found that PAIR showed a Restriction mailed on 11/4/2004. We never received this Restriction. The 6 month date was 5/4/2005.
→ Restriction mail date		11/4/2004		Dominic	If Document had been received ←
				M. Kotab	
Assignment	10/23/2001	11/21/2001	Yes	Dominic	(MDC Rule 5/7)
				M. Kotab	
Information Disclosure Statement	10/23/2001	8/30/2001	Yes	Dominic	(MDC Rule 6/13a-b)
				M. Kotab	
Filing Receipt	11/23/2001	9/26/2001	Yes	Dominic	(MDC Rule 2/52a-53a)
				M. Kotab	
Notice of missing parts - final	11/26/2001	11/21/2001	Yes	Dominic	
				M. Kotab	
Publication	2/23/2003	2/27/2003		Dominic	(MDC Rule 2/98)
				M. Kotab	
Status Inquiry	8/23/2003	8/5/2003	Yes	Dominic	Request for Status (MDC Rule 7/5a-7/13a)
				M. Kotab	
Status Inquiry	10/5/2003	8/19/2003		Dominic	This application will be examined in 0-3 months
				M. Kotab	
Status OA?	11/19/2003	9/10/2003		Dominic	
				M. Kotab	
Office Action 3 mos. Response Due	12/10/2003	11/19/2003	Yes	Dominic	Response to Restriction Requirement
	2/29/2004	2/23/2004		M. Kotab	
Status OA?	3/10/2004	1/29/2004		Dominic	OA DEADLINE - Shortened Statutory Period
				M. Kotab	
Office Action 3 mos. Status OA?	7/13/2004	7/12/2004	Yes	Dominic	
	7/29/2004	4/13/2004		M. Kotab	
				Dominic	
Check PAIR	8/12/2004	7/12/2004		M. Kotab	Confirmed - Confirm receipt of Amendment A
				Dominic	
Office Action 6 mos. Status OA?	10/13/2004	7/12/2004		M. Kotab	
	10/13/2004			Dominic	
				M. Kotab	
→ Restriction	12/4/2004			Dominic	If document had been received ←
				M. Kotab	
Petition to Revive	5/11/2005	5/11/2005		Dominic	Re-Docketed - Due to the restriction mailed 11/4/04 that we never received.
				M. Kotab	
Petition to Revive	5/18/2005	5/18/2005		Dominic	Re-Docketed- Date has passed- Due to the restriction mailed 11/4/04 that we never received.
				M. Kotab	
Petition to Revive	5/25/2005			Dominic	Due to the restriction mailed 11/4/04 that we never received.
				M. Kotab	
Petition to	6/1/2005			Dominic	Due to the restriction mailed 11/4/04 that

Patent Case Print [ID 201]

Page 3 of 3

Revive
Petition to
Revive 6/8/2005

M. Kotab we never received.
Dominic Due to the restriction mailed 11/4/04 that
M. Kotab we never received.

Inventors

Inventor	Custom Text #2	Assignment Date	Inventor Date #2	Inventor 1	Inventor 2	Real Number 1	Real Number 2
Robert Glenn Biskeborn							

Assignment

Assignment1 Reel/Frame Assignment Date
Assignment 012429/0241 1/3/2002

CreateUser: conv
CreateDate: 3/14/2003
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UpdateUser: Melissa
UpdateDate: 5/24/2005

Exhibit B

Exhibit B

PAIRConnect Patent Record

Downloaded 5/24/2005 12:59:00 PM

IBM1P008

IP MASTER

PAIR

Case Type: Regular
 Relationship: International Business Machines
 Filing Type: International Business Machines
 Filing #:

Dominic M. Kotab

Attorney Docket No.:
 Confirmation Number:
 Customer Number:

SD09-2001-0135US/I
 2227
 50548

Application Number: 09/938,457
 Publication Number: 2003-0040257
 Patent Number: 8/23/2001
 Filed Date: 2/27/2003
 Expiration Date:

Application Number: 09938457
 Publication Number: US 2003-0040257
 Patent Number: 8/23/2001
 Status: Non Final Action Mailed

Class Sub: 451/008
 Examiner: ELEY, TIMOTHY V
 Location: ELECTRONIC

Pin Adapter For Air Bearing Surface (Abs) Lapping And Method
 For Using The Same

Pre Issue Petition:
 Post Issue Pet.:
 PTO Adjustment:
 PTO Delay:
 Three Year Delay:
 Applicant Delay:
 Total PTA:

PAIR ADJ EST
 322
 0
 0
 322

IP Master Actions

PAIR Actions

IP Master Actions	Date	PAIR Actions	PAIR PTO	APP	ADJUSTED PTO	APP	ESTIMATED PTO	APP	Corrected Date
Petition to Revive	5/18/2005								
Petition to Revive	5/11/2005								
Notes	5/6/2005								
	3/7/2005	Correspondence Address Change							
	11/4/2004	Mail Restriction Requirement							
	11/1/2004	Requirement for Restriction / Election							
File Audit Date	10/26/2004								
	10/24/2004	Correspondence Address Change							
	8/27/2004	IFW TSS Processing by Tech Center Complete							
	8/27/2004	Date Forwarded to Examiner							
	7/12/2004	Workflow Incoming amendment IFW							
	7/12/2004	Response after Non-Final Action							
	7/12/2004	Reference capture on IDS							
Office Action 6 mos.	7/12/2004								
Office Action 3 mos.	7/12/2004								
Check PAIR	7/12/2004								
	4/13/2004	Mail Non-Final Rejection							
Status OA?	4/13/2004								
Office Action Mailed Date	4/13/2004								
	4/5/2004	Non-Final Rejection							
	3/2/2004	Date Forwarded to Examiner							
	2/23/2004	Response to Election / Restriction Filed							
Response Due	2/23/2004								
	1/29/2004	Mail Restriction Requirement							
Status OA?	1/29/2004								

5/24/2005 Page 1

